

### REMARKS

The continued thorough examination of the present application evidenced by the Office Action of April 28, 2010 (the Office Action) is appreciated. Assignee particularly appreciates the detailed response to arguments provided at pages 2-3 of the Office Action.

Responsibility for prosecution of the present application has been transferred to the undersigned attorney, who has taken a fresh look at the application. Accordingly, Assignee has amended Claims 21-22 to provide clarification thereof, and respectfully submits that all claims are patentable over the cited art for at least the reasons presented in the following remarks. Accordingly, a Notice of Allowance is respectfully requested in due course.

#### **Independent Claims 1 and 11 Are Patentable**

The Office Action has rejected independent Claims 1 and 11 under 35 U.S.C. Sec. 103(a) as allegedly being unpatentable over U.S. Publication No. 2003/0037261 to Meffert et al. (Meffert) in view of European Publication No. EP 1016972 to Nagai (Nagai). Office Action at 4. Claims 1 and 11, however, are patentable over the cited art for at least the reasons discussed below.

The Office Action explains that Nagai is cited merely to show text to image conversion, and that Meffert is cited as disclosing choosing to send an email in a protected mode. (Office Action at 2).

As previously noted, Meffert discusses "secured content delivery between a sender and a recipient in an electronic network using PKI-based encryption." (Meffert, Abstract). In pursuit of this end, Meffert discloses a system and method for selectively encrypting an outgoing email message using, for example, CAST-128 encryption, and digitally signing the encrypted message using a certificate based SHA-1 signed MD-5 hash value. (Meffert, para. 0083). Meffert further discloses that the encrypted package can be provided with an option for locking the message content to block the recipient from editing the text in the message upon saving or forwarding. (Meffert, para. 0094).

The Office Action contends that it would have been obvious to one of ordinary skill in the art to use the graphical conversion of Nagai with the security of Meffert because it allows

viewing without specific fonts and provides write protection. (Office Action at 4).

As recently stated by the U.S. Supreme Court, *KSR International Co. v. Teleflex Inc.*, et al., 550 U.S. 1, 14 (2007), to support a *prima facie* rejection under 35 USC § 103, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Furthermore, as set forth in MPEP § 2143, there must be a reasonable expectation that the modification will be successful. To that end, the MPEP further explains that the proposed modification cannot render the prior art unsatisfactory for its intended purpose, and cannot change the principal of operation of the reference. MPEP § 2143.01.

In the present case, modifying the system of Meffert to use the image conversion of Nagai would both change the principal of operation of the system of Meffert and render the system of Meffert unsuitable for its intended purpose.

Meffert discloses a system for "secured content delivery between a sender and a recipient in an electronic network using PKI-based encryption." Meffert, Abstract. As further discussed in Meffert, "PKI is a ... standard that uses ... encryption and digital certificate to achieve secure Internet services" (Meffert, para. 0007), and the sender or creator of content is permitted to "control the dissemination of that content even after it has been delivered to intended recipients" (Meffert, para. 0091).

In contrast, Nagai's image conversion is provided to increase (not restrict) access to content where e-mails are distributed randomly across different platforms, and provides no mechanism for securing the contents of the email or controlling the dissemination of the email content after it is delivered. If the encryption and/or digital signing of Meffert were replaced with the image conversion of Nagai, the system of Meffert would be unable to perform its intended functions of securing content during delivery and controlling use and access to the content after delivery thereof. Accordingly, Meffert would fail to perform according to its intended purpose if Meffert were modified to replace Meffert's encryption with Nagai's image conversion.

Furthermore, a skilled person would not perform the image conversion of Nagai in addition to the encryption and digital signing of Meffert, because doing so would add

additional complexity to the system without providing any benefit over the functions already performed by Meffert, as Meffert already requires no specific fonts to be used and provides write protection. A skilled person would therefore have no reason to either (1) replace the encryption and/or digital signing features of Meffert with the image conversion of Nagai or (2) perform the image conversion of Nagai in addition to the encryption and digital signing of Meffert.

For at least the reasons discussed above, Claim 1 is patentable over the cited art. In addition, Claim 11 is patentable for reasons similar to those discussed above with respect to Claim 1.

#### **The Dependent Claims Are Patentable**

Dependent Claims 4, 6-10, 12-15 and 17-18 stand rejected under 35 USC § 103 as unpatentable over Meffert in view of Nagai. Office Action at 4. Dependent Claims 3, 5, 19 and 20 stand rejected under 35 USC § 103 as unpatentable over Meffert in view of Nagai and further in view of U.S. Patent No. 6,711,608 to Ogilvie. Office Action at 5. Dependent Claims 21 and 22 stand rejected under 35 USC § 103 as unpatentable over Meffert in view of Nagai and further in view of U.S. Patent No. 6,577,907 to Czyszczewski. Office Action at 6.

Applicants traverse the rejection of dependent claims 3-10, 12-15, and 17-22. However, as each of these claims depends from a base claim that is believed to be in condition for allowance and the additional cited references do not appear to provide the teaching missing from Meffert and Nagai as discussed above, Applicants do not believe that it is necessary to argue the allowability of each dependent claim individually. Applicants do not necessarily concur with the interpretation of these claims, nor with the bases for rejection set forth in the Office Action. Applicants therefore reserve the right to address the patentability of these claims individually as necessary in the future.

#### **CONCLUSION**

All pending claims in the present application are in condition for allowance for at least the reasons discussed above, and a Notice of Allowance is respectfully requested in due

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course. The Examiner is encouraged to contact the undersigned attorney by telephone should any additional issues need to be addressed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David C. Hall". The signature is written in a cursive, flowing style with a large initial "D".

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